



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/658,737	09/09/2003	Amanda B. Mitchell	9538.18395-PROV FOR	3374
26308	7590	12/13/2005	EXAMINER	
RYAN KROMHOLZ & MANION, S.C. POST OFFICE BOX 26618 MILWAUKEE, WI 53226			NORDMEYER, PATRICIA L	
			ART UNIT	PAPER NUMBER
			1772	

DATE MAILED: 12/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/658,737

Applicant(s)

MITCHELL ET AL.

Examiner

Patricia L. Nordmeyer

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,6-12 and 14-22 is/are pending in the application.
- 4a) Of the above claim(s) 15-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,6-12,14 and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 21, 2005 has been entered.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1 – 4, 6 – 10, 12, and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Saferstein et al. (USPN 4,616,644).

Saferstein et al. disclose a strip of flexible material having a first side, a second side and a perimeter having predetermined configuration (Figures 1 – 3, #10), wherein the first side has at least portion thereof coated with an adhesive material (Column 3, line 29; Figures 1 – 3, #12), the second side being devoid of adhesive material (Column 3, lines 29 – 36) and a channel, or non-adhesive tabular area integrally formed with said strip comprising a pad (Figures 1 – 3, #20)

Art Unit: 1772

as stated in claims 1, 4, 6, 8, 9 and 22. With regard to claim 2, the first side of the flexible strip further comprises a first section forming an adhesive section (Figure 2, #12), a second section integrally formed between the first and third sections that forms a channel (Figures 1 – 3) and a third section forming an adhesive section (Figures 1 – 3). The securing system further comprises a removable backing material located on the first side of the material (Column 3, lines 37 – 43) as in claims 7 and 10.

With regard to the limitation of “for securing a bra strap relative to a second piece of fabric” in claims 1 – 4, 6 – 10, 12, and 22 and “said first piece of fabric slidingly secured within said channel” in claim 3, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. The bandage of Saferstein et al. is capable of performing the intended use as it two adhesive sections and non-adhesive section that forms a channel.

With regard to the limitations of “said second piece of fabric, said bra secured within said channel” in claim 1, “said second piece of fabric” in claim 2, “said first and third section of said strip of flexible material being adhesively connected to said second piece of fabric” in claim 3, “said second piece of fabric is a shirt” in claim 1 and “said channel formed by said strip of flexible material and said second piece of fabric, said bra secured within said channel, said second piece of clothing forming said channel, said channel sized to allow said bra strap to freely

Art Unit: 1772

slide within said channel, when said fabric system secured to said second piece of clothing” in claim 22, the material to which the fabric securing system is being attached is not claimed positively. According to the Figures 1, 2 and 2A of the specification of the application, the fabric securing system is defined at #10, which is the flexible material with the adhesive on one surface. Figure 3 of the specification shows the fabric securing system being used in combination with a person’s clothing, but the clothing is not included as part of the fabric securing system. Therefore, the person’s clothing is not positively claimed as part of the claimed invention.

4. Claims 1 – 4, 6, 8, 9, 11, 12, and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Delmore et al. (USPN 5,939,339).

Delmore et al. disclose a strip of flexible material having a first side, a second side and a perimeter having predetermined configuration (Figures 3), wherein the first side has at least portion thereof coated with an adhesive material (Column 7, line 18 – 23), the second side being devoid of adhesive material (Column 7, line 18 – 23) and a channel, or non-adhesive tabular area integrally formed with said strip comprising a pad (Figure 3, #32) as stated in claims 1, 4, 6, 8, 9 and 22. With regard to claim 2, the first side of the flexible strip further comprises a first section forming an adhesive section (Figure 3, #30), a second section integrally formed between the first and third sections that forms a channel (Figure 3, #32) and a third section forming an adhesive section (Figure 3). The securing system further comprises second non-adhesive tabs (Figure 3, #36 and Column 2, lines 47 - 52) as in claim 11.

With regard to the limitation of “for securing a bra strap relative to a second piece of fabric” in claims 1 – 4, 6 – 10, 12, and 22 and “said first piece of fabric slidingly secured within said channel” in claim 3, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. The bandage of Saferstein et al. is capable of performing the intended use as it two adhesive sections and non-adhesive section that forms a channel.

With regard to the limitations of “said second piece of fabric, said bra secured within said channel” in claim 1, “said second piece of fabric” in claim 2, “said first and third section of said strip of flexible material being adhesively connected to said second piece of fabric” in claim 3, “said second piece of fabric is a shirt” in claim 1 and “said channel formed by said strip of flexible material and said second piece of fabric, said bra secured within said channel, said second piece of clothing forming said channel, said channel sized to allow said bra strap to freely slide within said channel, when said fabric system secured to said second piece of clothing” in claim 22, the material to which the fabric securing system is being attached is not claimed positively. According to the Figures 1, 2 and 2A of the specification of the application, the fabric securing system is defined at #10, which is the flexible material with the adhesive on one surface. Figure 3 of the specification shows the fabric securing system being used in combination with a person’s clothing, but the clothing is not included as part of the fabric

Art Unit: 1772

securing system. Therefore, the person's clothing is not positively claimed as part of the claimed invention.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Saferstein et al. (USPN 4,616,644) in view of Clark et al.

Saferstein et al. discloses the claimed invention except for the second side of the flexible material having at least a portion of adhesive material.

Clark et al. discloses a bandage (Figure 1, #1) that is coated with an adhesive material (Figure 1, #8) on the second side of a flexible material (Column 7, lines 28 – 32) for the purpose of purpose of minimizing the movement of the bandage while in use (Column 7, lines 25 – 28).

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the double-sided adhesive on the second side of the bandage in Saferstein et al. in order to minimize the movement of the bandage while in use as taught by Clark et al.

Response to Amendment

7. The declaration under 37 CFR 1.132 filed November 21, 2005 is insufficient to overcome the rejection of claims 1 – 4, 7 – 12 and 14 based upon Taylor in view of Huang as set forth in the last Office action because: The applicant has provided no nexus between the evidence presented and the claimed invention. The presented evidence has no probative value since any unexpected results, commercial success or long felt need as other inventions have been made for the same purpose has shown by the prior art. Applicants have also failed to show that the results were greater than those that would have been expected from the prior art to an unobvious extent and that the results are of a significant practical advantage.

Response to Arguments

8. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Nordmeyer whose telephone number is (571) 272-1496. The examiner can normally be reached on Mon.-Thurs. from 7:00-4:30 & alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Y. Pyon can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1772

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Patricia L. Nordmeyer
Examiner
Art Unit 1772

pln
pln

Nasser Ahmad 12/8/05
NASSER AHMAD
PRIMARY EXAMINER
Acting SPE